

**REMARKS**

This is a full and timely response to the outstanding Office action mailed January 26, 2005. Upon entry of the amendments in this response claims 1-20 and 22-35 are pending. More specifically, claims 1, 3, 7, 9, 12, 14-16, 18, 19, 23-26, 28, 34, and 35 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application. Other statements not explicitly addressed herein are not admitted.

**I. Present Status of Patent Application**

Claims 1-3, 6-10, 12 and 14 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii*, (U.S. Patent No. 5,632,018) further in view of *Nakashima et al* (U.S. Patent No. 6,470,385). Claim 4 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Chuah et al* (U.S. Patent No. 6,400,722). Claim 5 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Kozdon et al* (U.S. Patent No. 6,456,601). Claim 11 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Rogers et al* (U.S. Patent No. 6,301,484). Claims 13, 20, and 22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Bookspan et al* (U.S. Patent No. 6,636,888). Claims 15, 26, and 30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Lewis* (U.S. Patent No. 6,513,019). Claims 28 and 31 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Ooe* (U.S. Patent No. 6,330,238). ). Claims 33 and 35 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* in view of *Lewis* (U.S. Patent No. 6,513,019) further in view of *Bookspan et al* (U.S. Patent No. 6,636,888).

## **II. Examiner Interview**

Applicant first wishes to express his sincere appreciation for the time that Examiner Avi Gold spent with Applicant's Attorneys Jeff Kuester and Benjamin Balser during a February 9, 2005 telephone discussion regarding the above-identified Office Action. Applicant believes that the format of a non-email broadcast message as not disclosed in *Otorii* or *Nakashima* were discussed during the telephone interview, and that they are resolved herein. During that conversation, Examiner Gold seemed to indicate that it would be potentially beneficial for Applicant to file these amendments and response. Thus, Applicant respectfully requests that Examiner Gold carefully consider these amendments and response.

## **III. Miscellaneous**

The term "non-email" was added to "broadcast messaging software in some amendments. Support for such amendments can be found in the specification on page 12, lines 9-11.

In the Office Action, certain subject matter is regarded as well-known. In particular, this subject matter includes, at least, using TIB Rendezvous software in messaging, using TCP/IP protocol in messaging, and using an MAPI interface for an email server. Applicants respectfully contend that all findings of well-known subject matter, including the aforementioned subject matter, have not been instantly and unquestionably demonstrated to be well-known. Even if the particular claim language taken separately were well-known, there is no factual basis for the legal conclusion that such claim language in combination with the other claim elements is well-known. Per MPEP 2144.03(B), "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." As specific factual findings predicated on sound technical and scientific reasoning in support of the conclusion of common knowledge are not provided in the Office Action, the subject matter should not be considered to be well-known.

#### IV. Rejections Under 35 U.S.C. §103(a)

##### A. Claims 1, 16, and 34

The Office Action rejects claims 1, 16, and 34 under 35 U.S.C. §103(a) as being unpatentable over *Otorii* (U.S. Patent No. 5,632,018 ) further in view of *Nakashima et al.*, (U.S. Patent No. 6,470,385). For the reasons set forth below, Applicant respectfully traverses the rejection. Each claim has a different combination of elements, which distinguish each claim from the references of record. Consequently, each claim should be analyzed separately for patentability.

##### **Independent claim 1** recites:

1. A method for sending electronic mail from a client operating within a client-server architecture, the method comprising the steps of:

- (a) ***provisioning the client with client non-email broadcast messaging software;***
- (b) provisioning a server with server non-email broadcast messaging software, wherein the server is in communication with the client;
- (c) broadcasting from the client a message in a format of the non-email broadcast messaging software, wherein the message contains the electronic mail;
- (d) receiving the message at the server;
- (e) reformatting the message from a format of the non-email broadcast messaging software to a format compatible with an email server; and
- (f) forwarding the reformatted message to the email server.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Otorii* and *Nakashima* do not disclose, teach, or suggest at least **provisioning the client with client non-email broadcast messaging software.**

The Office Action claims that *Otorii* teaches provisioning the client with client broadcast messaging software: “*Otorii* discloses a client broadcasting email.” See *Otorii*, col. 3, lines 51-65. However, non-email broadcast messaging software is not email software that broadcasts. It has a fundamentally different structure. This is corroborated in the claim itself as the format of the broadcast message is reformatted to be compatible with the email server.

Additionally, *Nakashima* discloses nothing about converting non-email broadcast messages to email messages. It only discloses the conversion of a message. Therefore, *Nakashima* does not disclose converting non-email broadcast messages to email messages, nor is it obvious to do so. To make the assertion that it is obvious would be averring that *Nakashima* makes the conversion between any two message types obvious. It simply does not.

#### **Motivation to Combine**

Applicant respectfully disagrees that there is motivation to combine the *Otorii* and *Nakashima* references. There must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the references to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more references, ***the references must properly suggest the desirability of combining the particular elements*** as claimed by the Applicant. Neither the *Otorii* nor *Nakashima* reference do so.

In response to Applicant’s previous assertion that there is no motivation to combine the *Otorii* and *Nakashima* references, the Office Action countered simply by asserting that “the knowledge is generally available to one of ordinary skill in the art” without offering any suggestion in the references to substantiate the assertion. Simply making an assertion does not suffice; there must be some evidence ***in the reference*** of the desirability of combining the particular elements. Thus, the combination of the *Otorii* and *Nakashima* references is improper.

**Hindsight**

Additionally, it appears that the combination of the *Otorii* and *Nakashima* references has been made using hindsight. "It is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

"(T)here must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It appears that, after viewing the elements of the claims, some of the elements were found in one reference and some in another. Those references were combined using only the hindsight and inventive aspects revealed by the disclosure and claims of the application. Therefore, it appears that hindsight has been used in this combination and the rejection is invalid.

In response to Applicant's previous assertion that the combination of the *Otorii* and *Nakashima* references was based on hindsight, the Office Action countered simply by asserting that the conclusion "takes into account only which was within the level of ordinary skill at the time the claimed invention was made" without offering any suggestion in the references to substantiate the assertion. Simply making an assertion does not suffice; there must be some evidence *in the reference* of the desirability of combining the particular elements. Thus, the combination of the *Otorii* and *Nakashima* references is improper.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of the independent claims. Notwithstanding, the undersigned has reviewed the entirety of the *Otorii* and *Nakashima* patents, and has failed to identify any such teaching anywhere within these references. Therefore, the rejection should be withdrawn. Claims 16 and 34 are allowable for similar reasons and the rejections of those claims should, likewise, be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons the independent claims are allowable.

B. Claim 29

The Office Action rejects claim 29 under 35 U.S.C. §103(a) as being unpatentable over *Otorii* (U.S. Patent No. 5,632,018 ) further in view of *Nakashima et al.*, (U.S. Patent No. 6,470,385). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 29** recites:

29. A method for sending an electronic mail comprising the steps of:

- (a) broadcasting from a client computer a message in a broadcast format, wherein the message contains the electronic email, wherein the client computer is part of a client-server architecture, and ***wherein the client computer does not have electronic mail software***;
- (b) receiving the message at a server computer of the client-server architecture;
- (c) reformatting the message from the broadcast format to an email format; and
- (d) forwarding the reformatted message to an email server that is compatible with the email format.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Otorii* and *Nakashima* do not disclose, teach, or suggest at least **wherein the client computer does not have electronic mail software**.

The Office Action claims that *Otorii* teaches provisioning the client with client broadcast messaging software: “*Otorii* discloses a client broadcasting email.” *See Otorii*, col. 3, lines 51-65. However, the software in *Otorii* is email software that broadcasts. It is email software on a client computer. Therefore, it cannot disclose wherein the client computer does not have electronic mail software.

### **Motivation to Combine**

Applicant respectfully disagrees that there is motivation to combine the *Otorii* and *Nakashima* references. There must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the ***references*** to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more references, ***the references must properly suggest the desirability of combining the particular elements*** as claimed by the Applicant. Neither the *Otorii* nor *Nakashima* references do so.

In response to Applicant's previous assertion that there is no motivation to combine the *Otorii* and *Nakashima* references, the Office Action countered simply by asserting that "the knowledge is generally available to one of ordinary skill in the art" without offering any suggestion in the references to substantiate the assertion. Simply making an assertion does not suffice; there must be some evidence ***in the reference*** of the desirability of combining the particular elements. Thus, the combination of the *Otorii* and *Nakashima* references is improper.

### **Hindsight**

Additionally, it appears that the combination of the *Otorii* and *Nakashima* references has been made using hindsight. "It is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

"(T)here must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It appears that, after viewing the elements of the claims, some of the elements were found in one reference and some in another. Those references were combined using only the hindsight and inventive aspects revealed by the disclosure and claims of the application. Therefore, it appears that hindsight has been used in this combination and the rejection is invalid.

In response to Applicant's previous assertion that the combination of the *Otorii* and *Nakashima* references was based on hindsight, the Office Action countered simply by asserting that the conclusion "takes into account only which was within the level of ordinary skill at the time the claimed invention was made" without offering any suggestion in the references to substantiate the assertion. Simply making an assertion does not suffice; there must be some evidence *in the reference* of the desirability of combining the particular elements. Thus, the combination of the *Otorii* and *Nakashima* references is improper.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 29. Notwithstanding, the undersigned has reviewed the entirety of the *Otorii* and *Nakashima* patents, and has failed to identify any such teaching anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons claim 29 is allowable.

C. Claims 2-15, 17-28, 30-33, and 35

Because the independent claims are allowable over the references of record, the corresponding dependent claims (which depend from the independent claims) are allowable as a matter of law for at least the reason that the dependent claims contain all the steps/features of the independent claims. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to the dependent claims should be withdrawn and the claims allowed.

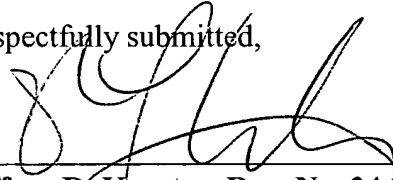
Additionally and notwithstanding the foregoing reasons for allowability of the independent claims, the dependent claims recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the references of record. Hence there are other reasons why the dependent claims are allowable.



**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-20 and 22-35 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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